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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Satoru Ueda

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11/15/2005

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EXAMINER

STRANGE, AARON N

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/819,244	UEDA, SATORU	
	<b>Examiner</b>	<b>Art Unit</b>	
	Aaron Strange	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see pages 10-11 of remarks filed 8/18/05, with respect to the 35 USC 112, first paragraph rejection of claim 2 have been fully considered and are persuasive. That rejection has been withdrawn.
2. With regard to the 35 USC 112, second paragraph rejection of claim 6, Applicant has failed to traverse the rejection or amend the claim. Therefore, the rejection is maintained.
3. Applicant's arguments with respect to the prior art rejections of claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. With regard to claim 6, the claim recites a "party identification means" for identifying a communication terminal from which the electronic mail is sent. This language is unclear. A "party identification means" seems to suggest identification of the party sending the message, rather than the communication terminal. Identifying a communication terminal does not identify a party since several parties may use a single communication terminal. The language of the specification suggests that the party identification means identifies the sender of the message, referring to a person (page 14, Lines 16-20 of the present application), and it has been interpreted as such for the purpose of applying prior art.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3,5, and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (US 6,640,301) in view of Zabetian et al. (6,327,656) in further view of Official Notice.

9. With regard to claim 1, Ng discloses a communication contents certification system for certifying contents of an electronic mail, comprising:

a communication contents certification apparatus (Email web site) (Fig 4, 20') having communication contents receiving means for receiving said electronic mail (messages are received through email web site) (Col 6, Lines 42-46), communication contents storage means for storing the contents of said electronic mail (Copies of sent email can be stored at the email web site) (Col 8, Lines 40-42), communication contents transmission means for transmitting said electronic mail (Messages are sent through email web site) (Col 6, Lines 42-46), and charging means for charging a fee associated with use of the communication contents certification apparatus (Col 14, Lines 21-26);

a first party communication terminal coupled to the communication contents certification apparatus (terminal containing browser) (Fig 4, 24) (Col 6, Lines 41-58);

a second party communication terminal coupled to the communication contents certification apparatus (terminal containing email client) (Fig 4, 15) (Col 6, Lines 41-58);

a first attorney communication terminal coupled to the communication contents certification apparatus (Col 13, Lines 62-65);

a second attorney communication terminal coupled to the communication contents certification apparatus (Col 13, Lines 62-65); wherein:

the electronic mail is transmitted from a first party communication terminal to at least one of an attorney communication terminal and another of the party communication terminals such that the electronic mail is routed to the communication contents certification apparatus and the communication contents certification apparatus obtains authentication information for the electronic mail, and stores the contents of the electronic mail (email is sent via the certification apparatus) (Col 8, Lines 19-29).

Ng fails to specifically disclose obtaining an identification and password of a sending party to authenticate the contents of the electronic mail or charging means for charging at least one of the parties for authenticating and/or certifying the contents of the electronic mail.

Zabetian discloses a similar system for certifying electronic mail and teaches authenticating the electronic mail based on an identification (source address) (Col 6, Lines 38-45) and password of the sending party (Col 6, Lines 63-64). This would have been an advantageous addition to the system disclosed by Ng since it allows the sender of the message to be positively identified, ensuring that the message actually came from a particular person.

The Examiner takes Official Notice that charging a fee for services rendered to a user is old and well-known in the art, and that it would be apparent to one of ordinary skill in the art at the time the invention was made to charge a sender or receiver a fee for certifying the electronic mail. Both Ng and Zabetian suggest charging users fees for various aspects of their services (NG, Col 14, Lines 22-25) (Zabetian, Col 6, Lines 45-49). Since it costs money to provide these services, it would have been advantageous to charge a fee to users in order to recoup these costs.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an identifier/password combination to authenticate the contents of an electronic mail and charge a fee to users of the certification system, since an ID/password combination allows the source of the message to be positively

identified and charging a fee allows the certification provider to recoup costs incurred in providing the service.

10. With regard to claim 2, while the system disclosed by Ng shows substantial features of the claimed invention (discussed above), including a GUI (Col 8, Lines 20-22), a party button display section for selecting electronic mail communication with the second party communication terminal wherein the first party communication terminal is adapted to transmit the electronic mail as a function of input to the GUI (Clicking on "Authenticated Send" button sends message to second party via certification apparatus)(Col 8, Lines 25-29), it fails to specifically disclose an attorney button display section for selecting electronic mail communication with said first attorney communication terminal.

However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to include an attorney button display because Applicant has not disclosed that a dedicated attorney button display provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well by specifying the attorney's email address and using the "Authenticated Send" button as disclosed by Ng (Col 8, Lines 19-29 and Fig 8A-8D) because both methods perform the required task of sending the message to the user's attorney via the certification apparatus equally well.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed by Ng to obtain the invention as specified in claim 2.

11. With regard to claim 3, Ng further discloses that the contents of the electronic mail relate to a contract matter (Terms of Sale) between said first party and said second party (Fig 8A-8D).

12. With regard to claim 4, Zabetian further discloses a method of confirming the reception of an electronic mail by having the recipient notify the certification requester (the certification apparatus in this case) upon successful receipt of the message. Zabetian discloses that this can be accomplished through a conventional return receipt or through an active login procedure to the email web site (Col 11, Line 63 to Col 12, Line 16).

13. With regard to claim 5, Ng further discloses that the electronic is encrypted (Col 14, Lines 45-47).

14. With regard to claim 6, Zabetian further discloses several methods of registering users for email service so their identity can be confirmed (Col 6, Line 54 to Col 7, Line 3).



15. Claims 7 and 8 are rejected for the same reasons as claims 1 and 3, since they recite subject matter which is wholly contained within those claims.

16. Claim 9 is rejected for the same reasons as claim 1, since it recites subject matter which is wholly contained within claim 1. Since the system disclosed by Ng is executed on computers, a computer readable recording medium holding the software to perform the method of claim 9 is inherent.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

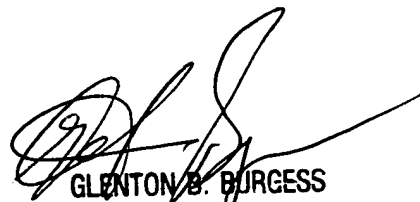
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2153

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AS  
11/3/2005



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